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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,981	01/17/2001	David K. Swanson	15916-282	5761

7590 07/14/2004

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EXAMINER

VRETTAKOS, PETER J

ART UNIT PAPER NUMBER

3739

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/761,981

Applicant(s)

SWANSON, DAVID K.

Examiner

Peter J Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 28-34 and 37-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9 and 37-57 is/are rejected.
- 7) ☒ Claim(s) 2-8 and 28-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7-12-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

The following action is **non-final**. An RCE was filed 6-29-04.

Claims 10-27 and 35-36 are cancelled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 9 and 49-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaFontaine et al. ('872) in view of Tu et al. ('140) and further in view of Saadat.

LaFontaine et al. discloses a surgical device that includes a malleable relatively short catheter shaft (14), a handle (12), an energy transmission device or electrode (38,89), and a tissue cooling apparatus or outer member (78) contains the fluid transmission space, which comprises fluid inlets (92) and outlets (96).

LaFontaine et al. also discloses a conductive fluid source (24) and supply line (26).

The tissue cooling apparatus is made up of a microporous structure (80), Surlyn or Latex. Note column 14 lines 61-63. The microporous structure or expandable member (80) also covers or envelops the energy transmission

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device (89). Note figure 5. The examiner asserts that the fluid transmission space is the empty area that makes up the inside of the bulbous tip of the expandable member (80) in figure 5.

Re: claims 7 and 8, LaFontaine discloses that the expandable member (80) in figure 5 can be constructed to form any desired configuration upon expansion (col. 15:4-7, and 60-64). The examiner contends that through routine experimentation one could easily deduce an annular expandable member configuration (and consequently a fluid transmission space that is annular) as determined by the tissues being treated. The annular configuration is common in the art – see Edwards 5,569,241 figure 5 element 34.

Re: claims 28-30, see figure 5.

Re: claims 31-32, and 57, optimal dimensions (diameters) would be determined through routine experimentation.

*LaFontaine et al., which has been described above, neglects to disclose a plurality of spaced energy transmission devices and coil electrodes.*

Tu et al. discloses a tissue ablation device that discloses a plurality of spaced energy transmission devices (14, col. 6:33-34) and coiled (and thereby relatively flexible, col. 6:34-36) electrodes.

A tissue cooling apparatus is asserted (2). Note column 4 lines 9-15. Outlet ports (21) are provided to allow the cooled fluid, which surrounds the electrode, exit from the catheter and onto the tissue.

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Tu et al. discloses a relatively short catheter shaft (1), two electrodes (14,12), a tissue cooling apparatus (2), an inlet lumen (20), and an outlet lumen or port (21). The examiner designates the fluid transmission spaces as the regions of lumen 20 in figure 3 that run perpendicular to the longitudinal axis of the catheter.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify LaFontaine et al. in view of Tu et al. by including more than one energy transmitting device. The motivation would be provide more precise means through selective activation for applying energy to targeted tissue.

2. Claims 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaFontaine et al. ('872) in view of Tu et al. ('140) and further in view of Swanson et al. ('903).

Lafontaine and Tu neglect to disclose an outer member that permits ionic transfer while preventing fluid perfusion.

Swanson in an analogous device discloses an outer member that permits ionic transfer while preventing fluid perfusion (col. 10:48-64).

Claims 38-48 each contain the same limitations from claims rejected in rejection #2 above toward Lafontaine and Tu and are applied in the same manner as before. Swanson is only needed in the instant rejection for the

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limitation in independent claim 37 toward an outer member that permits ionic transfer while preventing fluid perfusion.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify LaFontaine in view of Tu and further in view of Swanson by disclosing an outer member that permits ionic transfer while preventing fluid perfusion. The motivation would be provide a device that facilitates RF ablation through ionic transfer onto the targeted tissue, while avoiding the unwanted accumulation of conductive fluid at the surgical site.

### ***Response to Arguments***

Applicant's arguments filed 6-29-04 have been fully considered but they are not *entirely* persuasive. Applicant's arguments toward a distally extending drainage tube are sufficient to obviate the prior related rejections. The drainage tubes in the prior art are proximally extending. The related rejections are obviated (claims 1-8 and 27-34; sole independent claim 1). See Double Patenting section, *infra*.

Applicant's arguments toward a fluid supply line supported on the exterior of the probe shaft are not persuasive. Lafontaine discloses in figure 1, a fluid supply line (26) located external to the probe shaft.

The Applicant argues that the Office picks and chooses patented elements in rejections posited toward claims 37-48 involving LaFontaine, Tu, and Swanson. The Examiner respectfully disagrees. It is inappropriate to construct

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rejections in a vacuum. One must consider that obviousness is related to one of ordinary skill in the art, and not a complete novice to the art. The rejections have been assembled considering obviousness to one of ordinary skill. To this end, the Examiner contends that the rejections submitted above are indeed valid.

The Applicant argues that the Tu patent does not suggest placing more than one electrode *in an expandable member*, such as the member in LaFontaine. However, language toward electrodes inside an expandable member is not found in the related claims.

The Office contends that "judicial notice" has not been taken with regards to modifying Lafontaine in view of Tu by including more than one electrode. Lafontaine discloses one electrode, and Tu is presented to show disclosure of more than one electrode. The Applicant is asked to further clarify his position.

The Applicant argues that LaFontaine does not disclose prevention of fluid perfusion. Although this is true in LaFontaine, it is not accurate in Swanson. Swanson col. 10:50 line 50 reads, "to provide ionic transfer of radiofrequency energy without significant liquid flow through the material." This language expressly discloses that fluid perfusion is prevented in the disclosed expandable member.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re*

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*Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of double patenting over claim 19 of U. S. Patent No. 6,579,288 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Both claims disclose the drainage tube.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Allowable Subject Matter***



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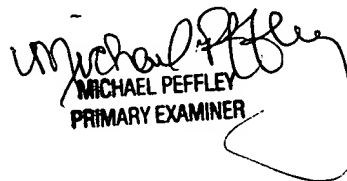
Claims 2-8 and 28-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pete Vrettakos whose telephone number is 703-605-0215. The examiner can normally be reached M-F 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Pete Vrettakos  
July 12, 2004



MICHAEL PEFFLEY  
PRIMARY EXAMINER